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In re Application of:
KOBATA, Hiroshi, et al. : DECISION ON REQUEST UNDER
U.S. Application No.: 10/550,574 : 37 CFR 1.497(d)
PCT No.: PCT/JP2004/004278 :
International Filing Date: 26 March 2004 :
Priority Date: 26 March 2003 :
Atty's Docket No.: 470223.00067 :
For: CONTROL DEVICE FOR :
HYDRAULIC CYLINDER :
:

This decision is issued in response to applicants' "Petition And Amendment To Correct Originally Named Inventors" and "Petition Under 37 CFR 1.47(a)" filed 12 September 2006. Applicant has submitted the required processing fee.

BACKGROUND

The procedural background for this application was set forth in the decision mailed by this Office on 11 July 2006. That decision dismissed as moot applicant's request for acceptance of the declaration without the signature of purported inventor Rollin C. CHRISTIANSON because Mr. CHRISTIANSON was not an inventor of record herein. The 11 July 2006 decision also stated that the declaration filed 22 September 2005, which listed Mr. CHRISTIANSON as an inventor, was unacceptable for failure to properly identify the inventors of record herein.

The 11 July 2006 decision went on to note the potential difficulties of adding Mr. CHRISTIANSON as an inventor herein, because any such request would require a statement under 37 CFR 1.497(d)(1) executed by Mr. CHRISTIANSON (who purportedly was refusing to execute documents for this application). The decision cited MPEP section 201.03(II)(A) with respect to applicants' possible alternatives, should Mr. CHRISTIANSON refuse to execute the 37 CFR 1.497(d)(1) statement required to add him as an inventor.

On 27 July 2006, the United States Designated/ Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of a proper declaration under 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date.

On 12 September 2006, applicants filed the "Petition And Amendment To Correct Originally Named Inventors" and "Petition Under 37 CFR 1.47(a)" considered herein. The

petitions seek to add Rollin C. CHRISTIANSON as an inventor and requests acceptance of the declaration without Mr. CHRISTIANSON'S signature.

DISCUSSION

1. Request To Add Inventor Under 37 CFR 1.497(d):

As stated in the previous decision, where, as here, the filed declaration names additional inventors who were not identified on the international application, 37 CFR 1.497(d) requires applicants to submit: (1) a statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intent; (2) the processing fee; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the consignee (in the form required by 37 CFR 3.73(b)).

Applicant here has submitted the required processing fee and the consent of the assignees to the requested change of inventorship. Items (2) and (3) are therefore satisfied. However, applicants have not provided the statement from Mr. CHRISTIANSON required under 37 CFR 1.497(d)(1). Item (1) is therefore not satisfied. Thus, the present record does not include all the requirements for the requested addition of Mr. CHRISTIANSON as an inventor herein.

Applicants state that the inventor has refused to sign the statement required under 37 CFR 1.497(d)(1); however, such a refusal does not eliminate the applicable requirement. As discussed in MPEP section 201.03(II)(A), and in the previous decision, where an inventor to be added or deleted refuses to execute the required statement of non-deceptive intent, the applicants have two options. They can either: (1) file a petition under 37 CFR 1.183 requesting waiver of the requirements of 37 CFR 1.497(d)(1); or (2) file a continuation application that names the proper inventors (i.e., the inventors of record, plus Mr. CHRISTIANSON), thereby alleviating the necessity of adding the missing inventor to the application under 37 CFR 1.497(d).

It is noted that a petition under 37 CFR 1.183 requires a \$400 petition fee, and such petitions are only granted in rare circumstances where justice requires the waiver of the applicable regulation and where applicants have no alternative remedy.

2. Petition Under 37 CFR 1.47(a):

As with the previous petition under 37 CFR 1.47(a) filed by applicants, the present petition under 37 CFR 1.47(a) is dismissed as moot because the inventor who is the subject of such petition (Rollin C. CHRISTIANSON) is not an inventor of record herein. The petition has therefore not been considered on the merits.

CONCLUSION

Applicant's request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

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Applicant's request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The declaration filed 22 September 2005 is defective for failure to properly identify the inventors of record herein.

Deposit Account No. 17-0055 will be charged the \$130 processing fee for the request under 37 CFR 1.497(d).

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)" and must include the statement from Rollin C. CHRISTIANSON required under 37 CFR 1.497(d)(1), as discussed above.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

As discussed above, the petition under 37 CFR 1.47(a) is premature and therefore has not been considered herein.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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